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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/845,537
Filing Date: April 30, 2001
Appellant(s): MOLANDER, MARK E.

Molander
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/04/2005 appealing from the Office action mailed 10/06/2004.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Google Toolbar (8 Pages) 02/02/2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-5, 7-17, 19-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Google (Google Toolbar).

In regards to claim 1, Google teaches a method of providing secondary functions from a menu item graphical control, said method comprising: including a plurality of graphical components with the menu item graphical control, each of the graphical components corresponding to a different programmed function (Page 1, Google Toolbar, Elements 2 and 3), wherein the menu item graphical control includes a default area in addition to the plurality of graphical components (Page 1, Google Toolbar, Element 1); displaying the menu item graphical control with the included graphical components and the default area, wherein each of the graphical components are displayed in a position horizontal to the default area (Page 1, Google Toolbar, Elements 1, 2, and 3); receiving a selection from a user corresponding to the menu item graphical control (Page 1, Google Toolbar, "Highlight: Highlight your search terms as they appear on the page, each word in its own color"); invoking a default function in response to the selection corresponding to the default area of the menu item graphical control (Page 1,

Google Toolbar, "Google Search: Access Google's search technology from any web page"); and in response to the selection corresponding to one of the graphical components, invoking the programmed function corresponding to the selected graphical component (Page 1, Google Toolbar, "Highlight: Highlight your search terms as they appear on the page, each word in its own color").

In regards to claim 2, Google teaches a method as described in claim 1 further comprising: displaying a sub-menu of selectable programmed functions in response to the user selecting a sub-menu graphical component (Page 2, Google Toolbar, "Page Info Menu: Gives you access to more information about the page that you are viewing. From this menu, you can choose three options").

In regards to claim 3, Google teaches a method as described in claim 1 wherein at least one of the graphical components includes a graphical icon that is displayed on the menu item graphical control (Page 1, Google Toolbar, Elements 1, 2, and 3).

In regards to claim 4, Google teaches a method as described in claim 1 further comprising: configuring the plurality of programmed functions using a configuration tool; modifying the menu item graphical control to include the graphical components corresponding to the configured programmed functions; and saving the configured plurality of programmed functions and the modified menu item graphical control (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box.").

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In regards to claim 5, Google teaches a method as described in claim 1 further comprising: configuring one or more secondary functions to include in a sub-menu; modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu; saving the secondary functions and the modified menu item (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box.").

In regards to claim 7, Google teaches a method as described in claim 1 wherein the programmed functions include one or more application programs (Page 5, Google Toolbar, Element 1).

In regards to claim 8, Google teaches a method as described in claim 1 wherein the programmed functions include one or more application functions corresponding to an application program and wherein the menu item graphical control corresponds to the application program (Page 1, Google Toolbar, Elements 1, 2, and 3).

Claim 9 is in the same context as claim 1; therefore it is rejected under similar rationale.

Claim 10 is in the same context as claim 2; therefore it is rejected under similar rationale.

Claim 11 is in the same context as claim 3; therefore it is rejected under similar rationale.

Claim 12 is in the same context as claim 4; therefore it is rejected under similar rationale.

Claim 13 is in the same context as claim 1; therefore it is rejected under similar rationale.

Claim 14 is in the same context as claim 2; therefore it is rejected under similar rationale.

Claim 15 is in the same context as claim 3; therefore it is rejected under similar rationale.

Claim 16 is in the same context as claim 4; therefore it is rejected under similar rationale.

Claim 17 is in the same context as claim 5; therefore it is rejected under similar rationale.

Claim 19 is in the same context as claim 7; therefore it is rejected under similar rationale.

Claim 20 is in the same context as claim 8; therefore it is rejected under similar rationale.

In regards to claim 21, Google teaches a method of providing secondary functions from a menu item graphical control, said method comprising: configuring one or more secondary functions to include in a sub-menu (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); modifying the menu item graphical control to include a sub-menu graphical component corresponding to the sub-menu, wherein

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the menu item graphical control further includes one or more graphical components corresponding to one or more programmed functions (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); and displaying the sub-menu in response to a user selecting the sub-menu graphical component (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box.").

Claims 23 and 25 are in the same context as claim 21; therefore they are rejected under similar rationale.

In regards to claim 22, Google teaches a method of providing secondary functions from a menu item graphical control, said method comprising: configuring a plurality of programmed functions using a configuration tool (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); identifying a plurality of graphical components for each of the programmed functions (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); modifying the menu item graphical control to include the graphical components corresponding to the configured programmed

functions (Page 5, Google Toolbar, "Toolbar Options: This menu allows you to customize your toolbar in a number of ways: Set behavior of text box. Select whether you want text explanations for the buttons or only icons. Select the width of the text box."); displaying the menu item graphical control with the included graphical components (Page 1, Google Toolbar, Elements 1, 2, and 3); receiving a selection from a user corresponding to one of the graphical components (Page 1, Google Toolbar, "Highlight: Highlight your search terms as they appear on the page, each word in its own color"); and invoking the programmed function corresponding the selected graphical component (Page 1, Google Toolbar, "Highlight: Highlight your search terms as they appear on the page, each word in its own color").

Claims 24 and 26 are in the same context as claim 22; therefore they are rejected under similar rationale.

(10) Response to Argument

The applicant argues:

- a. Google Toolbar is not a menu item graphical control as taught and claimed by the Applicant and it does not contain a plurality of graphical components where each of the graphical components corresponds to a different programmed function.
- b. Google Toolbar is not prior art to Appellant's claimed invention.

In regards to argument (a), the Examiner respectfully disagrees. The Examiner points out that "menu item graphical control" is never specifically defined in the specification. The Examiner believes that a toolbar is considered a menu item graphical

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control because it controls menu items. Items can be added and removed from the toolbar. Each of the menu items on the toolbar correspond to a different programmed function (i.e. "search site" and "search"); furthermore there is a drop down sub-menu for even more options. For these reasons the Examiner believes that the Google Toolbar is proper prior art and does teach all the limitations claimed by the Applicant.

In regards to argument (b),

The declaration filed on 03/07/2005 under 37 CFR 1.131 has been considered but is ineffective to overcome the Google Toolbar reference.

1. FORMALITIES

The declaration must include an acknowledgment by the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that **all statements made of the declarant's own knowledge are true** and that all statements made on information and belief are believed to be true. (MPEP 715.04)

The Applicant declaration simply states, "all statements made herein of my own knowledge and all statements made on information and belief are believed to be true." Nowhere in the declaration does the applicant state that all statements made of the declarant's own knowledge are true.

On its face, Applicant's Affidavit filed on 03/07/2005 is invalid and bears no weight.

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2. Nevertheless, the Examiner has reviewed the Exhibit and offers applicant the following guidance. Note that these comments are merely exemplary and are not comprehensive. Applicant bears the burden of establishing prior invention.

3. Applicant is attempting to show prior invention by proving conception prior to February 02, 2001 (the effective date of the Google Toolbar Reference) coupled with diligence from that date until the filing of the instant application on April 30, 2001.

4. CONCEPTION

The affidavit or declaration and exhibits must clearly explain which facts or data applicant is relying on to show completion of his or her invention prior to the particular date. Vague and general statements in broad terms about what the exhibits describe along with a general assertion that the exhibits describe a reduction to practice "amounts essentially to mere pleading, unsupported by proof or a showing of facts" and, thus, does not satisfy the requirements of 37 CFR 1.131(b). In re Borkowski, 505 F.2d 713, 184 USPQ 29 (CCPA 1974). Applicant must give a clear explanation of the exhibits pointing out exactly what facts are established and relied on by applicant. 505 F.2d at 718-19, 184 USPQ at 33. See also In re Harry, 333 F.2d 920, 142 USPQ 164 (CCPA 1964) (Affidavit "asserts that facts exist but does not tell what they are or when they occurred."). (MPEP 715.07)

While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be comprehended. See *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897). (MPEP 715.07)

5. Exhibit A appears to have been created prior to February 02, 2001, but the version supplied was last modified on June 13, 2002. The affected content of this modification is not clear.

Applicant attempts to establish conception by stating in paragraph 2a of the affidavit:

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"I submitted IBM Invention Disclosure Form No. RSW8-2000-0109, attached as Exhibit A hereto, which describes the invention described and claimed in the subject application."

This is the sole explanation of the conception of the invention. Examiner notes that this is at most a general assertion that the referenced Exhibit discloses the invention. This is no more than a general pleading and is inadequate to establish conception.

Applicant has not provided a "clear explanation of the exhibits pointing out **exactly** what facts are established" and how they support conception of the claimed invention.

6. It is the Examiner's opinion that Exhibit A does not have the degree of detail necessary to support conception even with a properly structured affidavit, because Exhibit A also fails to reach the degree of specificity found in the claims presented.

For example, at least these limitations from claim 1 are not supported by Exhibit A:

including a plurality of graphical components with the menu item graphical control, each of the graphical components corresponding to a different programmed function, wherein the menu item graphical control includes a default area in addition to the plurality of graphical components

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invoking a default function in response to the selection corresponding to
the default area of the menu item graphical control

7. Note again, that these comments are not comprehensive, merely illustrative in nature. Applicant bears the burden of providing a clear explanation (as part of the affidavit) as to how the supporting Exhibits establish prior invention. Therefore, Applicant has not established that conception occurred prior to the effective date of the reference.

8. DILIGENCE

In determining the sufficiency of a 37 CFR 1.131 affidavit or declaration, diligence need not be considered unless conception of the invention prior to the effective date is clearly established, since diligence comes into question only after prior conception is established. *Ex parte Kantor*, 177 USPQ 455 (Bd. App. 1958). (MPEP 715.07(a))

Accordingly, the Examiner need not address diligence at this point. However, in the interest of compact prosecution the Examiner will comment on applicant's attempted showing of diligence.

9. The critical period in which diligence must be shown begins just prior to February 02, 2001 (the effective date of the Google Toolbar Reference), and ends on April 30, 2001, the filing date of the instant application.

An applicant must account for the entire period during which diligence is required. *Gould v. Schawlow*, 363 F.2d 908, 919, 150 USPQ 634, 643 (CCPA 1966).

The diligence of 35 U.S.C. 102(g) relates to reasonable "attorney-diligence" and "engineering-diligence" (*Keizer v. Bradley*, 270 F.2d 396, 397, 123 USPQ 215, 216 (CCPA 1959)).

Diligence requires that applicants must be specific as to dates and facts. The period during which diligence is required must be accounted for by either affirmative acts or acceptable excuses. (MPEP 2138.06)

Applicant's showing of diligence is clearly insufficient. For Example, the Applicant simply states, "I worked diligently with a patent attorney in order to file the

subject application on April 30, 2001". However the Applicant is not specific with regards to facts and dates. There is no activity shown between the date of conception and the filing date of the instant application

It appears that Applicant may be relying on Attorney's actions during the critical period. If so, then an affidavit by the attorney may be needed. (See penultimate section of MPEP 2138.06 "Diligence in Preparing and Filing Patent Application").

Note, that these comments are not comprehensive and are merely a courtesy to applicant to help expedite the prosecution.

10. The evidence submitted is insufficient to establish diligence for the critical period.

11. To summarize: The affidavit is insufficient based on (a) Formal deficiencies (b) an inadequate showing of conception and (c) an inadequate showing of diligence. Therefore, Applicant has failed to prove prior invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Boris Pesin



Conferees:

Kristine Kincaid

Kristine Kincaid
KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

John Cabeca

John Cabeca
JOHN CABECA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100